Remarks

At the time of the Office action, claims 2-12 were pending in the application. This response amends claims 2 and 8, and claims 2-12 remain pending in the application.

Rejection of Claims 2-4, 7-9 and 12 Under 35 U.S.C. § 102(b).

Claims 2-4, 7-9 and 12 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,260,289 to Whitten, ("Whitten"). Office Action, p. 2. Claim 2 is independent and claims 3-4 and 7 depend from claim 2. Claim 8 is independent and claims 9 and 12 depend from claim 8. In order for Whitten to anticipate claims 2-4, 7-9 and 12, Whitten must teach every element of each of claims 2-4, 7-9 and 12. *See* MPEP § 2131; *see also*, *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully contend that Whitten does not teach every element of each of claims 2-4, 7-9 and 12.

Independent claims 2 and 8 have been amended to include the limitation of a "bearing fixedly mounted to the saw." Whitten does not disclose a bearing fixedly mounted to the saw, but rather, discloses a shaft rotatably mounted to the saw. Therefore, Whitten does not disclose each and every element of claims 2 and 8.

Additionally, claim 2 and 8 are not obvious over Whitten. If the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). In Whitten, the essential function of the invention depends on the shaft 14 rotating with respect to the saw. Every stated object of Whitten relates to converting rotatary

motion to reciprocating motion. Whitten, col. 1, ll. 9-45. If the shaft were fixedly mounted, the Whitten invention could not convert rotary motion to reciprocating motion. A proposed modification to fixedly mount the shaft 14 would render Whitten unsatisfactory for its intended purpose. Accordingly, there can be no suggestion or motivation to modify Whitten such that Whitten would anticipate claims 2 and 8. Therefore, claims 2 and 8 cannot be obvious over Whitten.

Applicants believe, for at least the reasons stated herein, that claims 2 and 8 are allowable and respectfully request that the rejection of these claims be withdrawn. Additionally, claims 3-4 and 7 depend from claim 2, and claims 9 and 12 depend from claim 8. Therefore, claims 3-4, 7, 9 and 12 should be patentable for at least the same reasons as those discussed above with respect to claims 2 and 8.

Rejection of Claims 5-6 and 10-11 Under 35 U.S.C. § 103(a).

Claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whitten. Office Action, p. 2 Claims 6 and 11 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Whitten in view of U.S. Patent No. 5,988,034 to Okubo, *et al. Id.* Claims 5-6 depend from claim 2, and claims 10-11 depend from claim 8. As discussed above, Applicants respectfully submit that claims 2 and 8 are not obvious in light of Whitten, and therefore, the added limitations of claims 5-6 and 10-11 would not be obvious. Accordingly, Applicants respectfully traverse the rejection of claims 5-6 and 10-11 and request that the rejection of these claims be withdrawn.

Conclusion

Applicants believe that all of the rejections in the Office action have been addressed by the amendments and remarks above. If there are any questions regarding this Response, Applicants welcome a telephone call or interview with the Examiner and the undersigned Applicants' representative.

If any additional fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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